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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,663	02/03/2005	Keiji Otaki	122381	9411

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EXAMINER

O HERN, BRENT T

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/520,663

Applicant(s)

OTAKI ET AL.

Examiner

Brent T. O'Hern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3 Feb. 2005, 10 Jan. 2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-7 and 9-16 in the reply filed on 24 August 2006 is acknowledged. The traversal is on the ground(s) that the subject matter is sufficiently related that a search of on any one Group of claims encompass a search for the subject matter of the remaining claim. This is not found persuasive because the inventions of Groups I and II do not relate to a single general inventive concept as stated in the Office Action dated 24 April 2006.

The requirement is still deemed proper and is therefore made **FINAL**.

Information Disclosure Statement

2. The information disclosure statement filed 10 January 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (*See non-translated Japanese references 2-4.*). It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

3. The drawings are objected to because of the following informalities:

-Pages 9-10 of Applicant's Specification, last paragraph of both pages "articles 3" note present in FIGs, perhaps Applicant is referring to #31, #32, #33 and #34.

-Page 10, last paragraph: "cut built-up articles 31, 34", perhaps Applicant means "31-34".

-Page 11, paragraph 2, "articles 31, 34 are rotated", perhaps Applicant means "331, 334".

-Page 11, paragraph 4, "built-up articles 31, 34", perhaps Applicant means "331, 334".

-Page 12, line 4, "coat 5", perhaps Applicant means "51" or "52".

-Page 18, paragraph 4, "three mats 4". Mats 4 is not present in FIG.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate, changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7 and 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase **“cutting direction”** in claim 1, line 11 is vague and indefinite because it is unclear to one of ordinary skill in the art what is the cutting direction of the insulator.

The phrase **“and the adhesive agent is partially applied to the insulator and/or the facing material”** in claim 5, lines 2-3 is vague and indefinite because it is unclear to one of ordinary skill in the art what is the difference between applied and applied partially.

The phrase **“and the adhesive agent is entirely applied to surfaces of the insulator and/or the facing material”** in claim 6, lines 2-3 is vague and indefinite because it is unclear to one of ordinary skill in the art what is the difference between entirely applied and surface entirely covered.

Clarification and/or correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

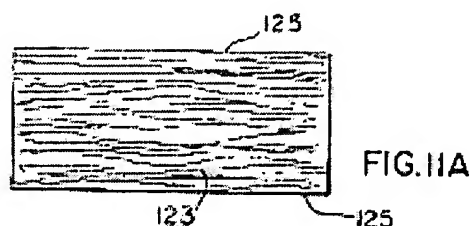
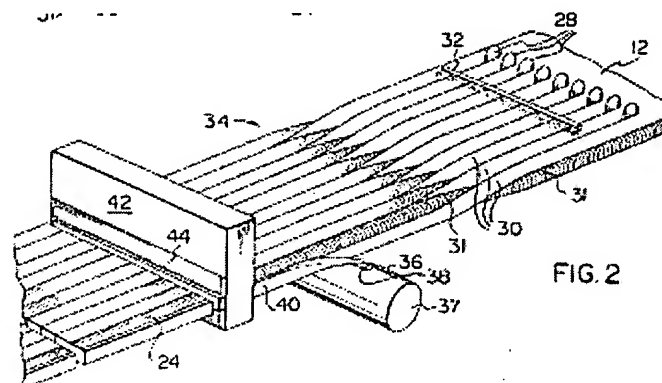
A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Cameron et al. (US 4,552,793).

Regarding claim 1, Cameron ('793) teaches a mat-shaped thermal insulator made of inorganic fiber (*col. 4, ll. 31-33 and FIG-2, #12*), wherein at least a part of inorganic fibers is built-up in a direction parallel to lateral surfaces of the insulator (*col. 5, ll. 9-11 and col. 8, ll. 41-45 and FIG-11A, #123*), and



The phrase "said insulator is formed by cutting a fibrous built-up article formed by building-up inorganic fibers, to form cut built-up articles, rotating at least one of the cut articles by an angle of 90 degrees in a direction perpendicular to a longitudinal direction, to form a rotated built-up article in which the inorganic fibers are built-up in a direction parallel to lateral sides of the cut article, and integrating the cut articles and/or the

rotated article transversally in a direction perpendicular to cutting direction" in claim 1, lines 4-11 are **process limitations** in a product claim and hence not given any patentable weight since patentability of a product does not depend on its method of production (see MPEP 2173.05(p)).

Regarding claim 2, Cameron ('793) teaches an insulator wherein the lateral surfaces of the insulator are inclined (*col. 5, ll. 18-21 and FIG-2, #31*).

Regarding claims 3 and 9, Cameron ('793) teaches an insulator wherein longitudinal cuts are formed on the lateral surfaces of the insulator (*col. 5, l. 20, FIG-2, cutters #28*).

The phrase "so as to make the insulator partially compressible" in claims 3 and 9, lines 2-3 of both claims is not given any patentable weight since the applicant is introducing **use** limitations into the product claims (see MPEP 2173 (q)).

Regarding claims 4, 10 and 11, Cameron ('793) teaches an insulator wherein at least one of the surfaces of the insulator is coated by a facing material (*col. 5, ll. 63-66 and FIG-2, #36*).

Regarding claims 5-6, Cameron ('793) teaches an insulator wherein the insulator and the facing material are bonded to each other by means of an adhesive agent (*col. 5, ll. 3-6*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 4,552,793) in view of Berdan, II (US 5,350,063).

Cameron ('793) teaches wherein each of the mat-shaped inorganic fiber thermal insulators, inorganic fibers are built-up in a direction of a width of the aligned article (FIG-11A, #123), however, fails to expressly teach a package and wherein the package comprises a packaging bag.

However, Berdan, ('063) teaches a package and wherein the package comprises a packaging bag (col. 1, ll. 18-20 and FIG-8) for the purpose of purpose of reducing transportation costs (col. 1, ll. 14-18).

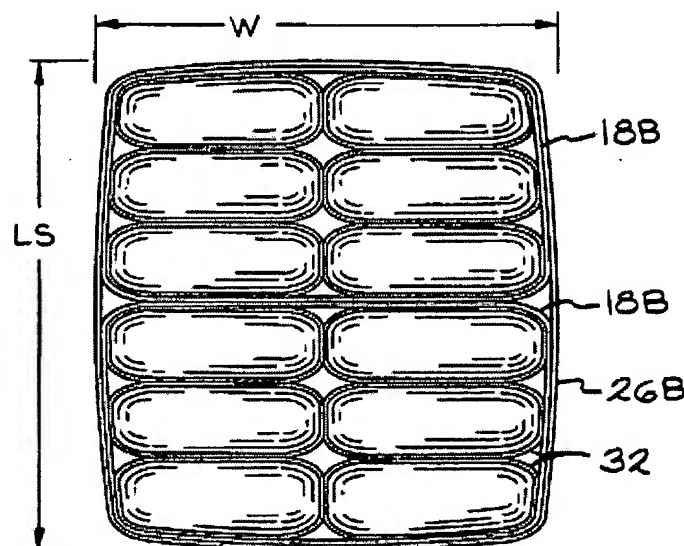


FIG. 8

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to modify Cameron's ('793) insulator with a

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packaging bag as taught by Berdan, ('063) in order to provide a packaged article with reduced transportation costs.

The phrases "said aligned articles are compressed transversally, said aligned articles are formed by arranging a plurality of mat-shaped inorganic fiber thermal insulators according to claim ... in parallel and/or by laying the insulators one on the other" in claims 7 and 12-16, lines 4-8 of all claims are **process limitations** in a product claims and hence not given any patentable weight since patentability of a product does not depend on its method of production (see MPEP 2173.05(p)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-F, 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-2172. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brent T O'Hern
Examiner
Art Unit 1772
September 15, 2006


NASSER AHMAD
PRIMARY EXAMINER
9/15/06